

REMARKS

Following entry of the foregoing amendments, claims 5-7, 12-18, 23, 27-28, 30-32, and 34-42 constitute the pending claims in the present application. Claims 1-4, 8-11, 19-22, 24-26, 29, and 33 are cancelled.

Amendments

In order to more particularly claim the present invention, Applicants have amended claims 5 and 30 to incorporate subject matter from claims 11 and 33, respectively. As such, claims 5 and 30 now recite that “the guest moiety is selected from adamantyl, naphthyl, cholesterol, and combinations thereof.” Applicants have cancelled claims 11 and 33, now redundant. Moreover, Applicants have amended claims 5 and 30 to delete the phrase “at a terminus of the complexing agent.” Applicants note that the deletion of this phrase in no way narrows claims 5 and 30 or claims dependent thereon.

Applicants have also amended the claims to delete the non-elected subject matter. Hence, claims 20-21 have been cancelled and claims 5, 12-13, 30, and 35-36 amended accordingly.

Applicants submit the above amendments present no new matter and reserve the right to pursue similar subject matter to the unamended and/or cancelled claims in subsequent divisional and/or continuation applications.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the prior Office Action.

Withdrawal of Rejections

Applicants note with appreciation the withdrawal of the obviousness-type double patenting rejection of claims 5-7 and 11-21 over claims 14-20 of U.S. Application No. 10/021,312 to Applicants.

Allowable Subject Matter

Applicants note with appreciation that claims 11 and 33 have been found allowable, save for their dependence upon a rejected base claim that “requires a ‘guest’ on the complexing

agent.” As noted above, Applicants have incorporated the subject matter of claims 11 and 33 into claims 5 and 30, respectively. Accordingly, Applicants submit that claims 5 and 30 and claims dependent thereon are also allowable. Regarding the recitation of a complexing agent comprising a “guest,” as noted above, on indication that generic claims 5 and 30 are otherwise allowable, examination of the full scope of the generic claims is proper.

1. Claim Rejections – 35 USC 112, First Paragraph

The Examiner has rejected claims 5-7, 11-18, 23, and 26-41 under 35 USC 112, first paragraph as failing to comply with the written description requirement contending that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that Applicants had possession of the invention at the time the application was filed. In particular, the Office objects to the recitation in claim 5 and, presumably, claim 30 that at least one guest moiety is “at a terminus of the complexing agent.”

Although, Applicants disagree with the Examiner’s position and contend that the specification fully describes the previously claimed subject matter as embodiments of the invention for reasons already of record, as mentioned above, Applicants have amended claims 5 and 30 to delete the disputed language from the claims, thus rendering the rejection moot. Accordingly, Applicants request reconsideration and withdrawal of the rejection of claims 5 and 30 and claims dependent thereon.

2. Claim Rejections – 35 USC 102(e)

Claims 5-7, 12-18, 23, 26-27, 29-32, and 34-41 are rejected under 35 USC 102(e) as allegedly being anticipated by US 6,740,643 to Wolff et al. (“Wolff”). The Office states that “Wolff discloses several compositions comprising a cyclodextrin-containing polymer, plasmid DNA and a complexing agent...Example 6 comprises a composition including a polymer containing cyclodextrins in the side chains, plasmid DNA and Triton-X 100 (a PEG ether of octylphenol).” Applicants respectfully traverse the rejection to the extent that it is maintained over the claims as currently amended.

The Office appears to consider the Triton X-100 (“TX”) of Wolff to be synonymous with the complexing agent of the present claims. As noted by the Examiner, TX is a PEG ether of

octylphenol. However, TX is not a complexing agent comprising a guest moiety selected from adamantyl, naphthyl, cholesterol, and combinations thereof. Accordingly, Wolff does not teach all the elements of current claims 5 and 30. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (see MPEP 2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Since Wolff does not satisfy this requirement, it does not anticipate claims 5 and 30 or claims dependent thereon. As such, Applicants request reconsideration and withdrawal of the rejection over Wolff.

3. Claim Rejections – 35 USC 103(a)

Claims 5-7, 12-18, 23, 26-27, 29-32, and 34-41 are rejected under 35 USC 103(a) as allegedly being obvious over Wolff. Applicants respectfully traverse the rejection to the extent that it is maintained over the claims as currently amended. Pursuant to MPEP 2142, “[t]o establish a prima facie case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As noted above, Wolff does not teach all the features of the pending claims as currently amended, in particular, a complexing agent comprising a guest moiety selected from adamantyl, naphthyl, cholesterol, and combinations thereof. Moreover, there is no apparent suggestion of the particular combination of features recited in current claims 5 and 30.

Furthermore, there is no motivation provided by Wolff and/or the knowledge in the art at the time of filing to modify the teachings of Wolff to arrive at the present claims. Considering that Wolff does not teach all the limitations of the present claims and the lack of motivation to modify Wolff to arrive at said claims, Applicants assert that claims 5 and 30 and claims dependent thereon are not rendered obvious by Wolff. Accordingly, Applicants request reconsideration and withdrawal of the rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

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Respectfully Submitted,



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